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EXAMINER	
GOLINKOFF, JORDAN	
ART UNIT	**PAPER NUMBER**
2174	

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/837,392	PAUL ET AL.	
	Examiner	Art Unit	
	Jordan S Golinkoff	2174	

-- The MAILING DATE f this c mmunication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Please note, the following office action will only consider claim numbers 1-34 and not claims 1-36 as stated in the preliminary amendment as claims 35 and 36 could not be found. The examiner assumes that this was a typographical error.

Information Disclosure Statement

1. The information disclosure statement filed 4/18/2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01 (pages 1-2).

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they

must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 18q should be renumbered 18r. Additionally, the preliminary amendment states to add claims 19-36. However, only claims 19-34 have been added.

4. Claims 5-7 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 5 – 7 could be rewritten as one claim to mirror the claim language in claim 23 or they could be rewritten to all depend on claim 4. This is necessary because claims 5-7 are now mutually exclusive as a wave file cannot also be an mp3 file.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 15 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 15 and 31 state that the client can perform only steps g through k. However, steps h and j in claims 2 and 8 respectively are performed only by the client system not the client

(see p.5 of Specifications, line 18 and lines 27-28, *users can order sounds with photographs but do not record the sounds*).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiimori (US # 6567983).

As per independent claim 1, Shiimori teaches a method of producing and viewing an audio-visual presentation under the control of a client system for access by creator clients and guest clients, said method comprising:

(a) displaying the visual elements of said audio-visual presentation (column 1, lines 50-51).

(b) recording the audio elements of said audio-visual presentation at a site remote from said client system (column 4, lines 17-22).

(c) uploading said audio elements of said audio-visual presentation to said client system (column 4, lines 21-22).

(d) associating each of said audio elements with a corresponding visual element (column 4, lines 27-36).

(e) generating a text file containing the text elements of said audio-visual presentation at a site remote from said client system (column 7, lines 46-48).

(f) uploading said text elements of said audio-visual presentation to said client system (column 7, lines 46-48).

(g) displaying said visual, text and associated audio elements for playback; whereby both said audio, visual and text elements of said audio-visual presentation may be viewed and heard respectively by a client (column 4, lines 23-24, and Figure 23, element 105 *text is downloaded as well to be displayed with image*).

Claim 19 is similar in scope to Claim 1, and is therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2-7, 18, 20-23, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori (US # 6567983) in view of Microsoft Outlook 2000 ("MS Outlook", Microsoft Screen Dumps figures 3-6).

As per claim 2, which is dependent on claim 1, Shiimori teaches a method of producing and viewing an audio-visual presentation under the control of a client system for access by creator clients and guest clients. Shiimori does not disclose a method notifying the creator client

that the guest client has viewed and heard the audio-visual presentation. MS Outlook teaches that it is known to notify the creator of information when it has been viewed by another (figures 3-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the ability to notify the creator when the presentation had been viewed, as taught by MS Outlook, to a method of producing and viewing a presentation, in order to document and track those who have seen the presentation.

As per claim 3, which is dependent on claim 2, Shiimori teaches that visual elements comprise digital representations of photographs (column 1, line 23).

As per claim 4, which is dependent on claim 3, Shiimori teaches that audio elements represent digitally recorded files (column 4, line 18, *audio files stored on a server must be digital*).

As per claim 5, which is dependent on claim 4, Shiimori teaches that audio elements are WAV files (figure 11b, *specifies the use of a .wav file for the music file in line 2*).

Claims 20, 21, 22, and 34 are similar in scope to claims 2, 3, 4, and 18 respectively, and are therefore rejected under similar rationale.

As per claims 6 and 7, which are dependent on claims 5 and 6 respectively, Shiimori teaches that audio elements are WAV files (figure 11b). Shiimori does not disclose that audio elements are MPG files or MP3 files. Official Notice is taken that it is known that these file types are interchangeable. MPG, MP3 and WAV files are all file formats used to digitally store audio data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include well known MPG and MP3 files with WAV files, of Shiimori, in the recognized digital audio formats in order to allow the user more flexibility.

Claim 23 is similar in scope to claims 5-7, and are therefore rejected under similar rationale.

11. Claim 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori (US # 6567983) in view of Microsoft Outlook 2000 ("MS Outlook", Microsoft Screen Dumps figures 3-6) as applied to claim 7, and further in view of Lemelson et al. ("Lemelson", US # 6608972).

As per claim 8, which is dependent on claim 7, the combination of Shiimori and MS Outlook teach a method of producing and viewing an audio-visual presentation under the control of a client system for access by creator clients and guest clients. As per claim 8i, Shiimori teaches placing an online order for a hard copy of said photographs (column 13, lines 48-53). The combination of Shiimori and MS Outlook do not disclose: recording a sound file on an audio playback means which is attached to a hard copy of a photograph or placing an online order for an audio playback means which is attached to a photograph, whereby a user may obtain a hard copy of a photograph and the audio associated with the photograph for playback by the user without access to the internet. Lemelson teaches that it is known to display a photograph with a means for recording and playing a sound (column 2, lines 38-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a means for recording and playing audio associated with a photograph, as taught by Lemelson, with a method of producing and viewing a presentation as well as ordering hard copies of photographs, to allow guest of a client system the capability of ordering both the visual and audio aspects of a presentation or photograph. This would allow guests an opportunity to more fully capture the

entirety of the experience of the audio-visual presentation for the sake of posterity or for future reference.

Claim 24 is similar in scope to claim 8, and is therefore rejected under similar rationale.

12. Claim 9-12 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori (US # 6567983) in view of Microsoft Outlook 2000 ("MS Outlook", Microsoft Screen Dumps figures 3-6) and Lemelson et al. ("Lemelson", US # 6608972) as applied to claim 8, and further in view of Microsoft Sound Recorder ("MS Recorder", Microsoft Screen Dumps figures 1-2).

As per dependent claim 9, Shiimori teaches a method of producing and viewing an audio-visual presentation under the control of a client system for access by creator clients and guest clients. Shiimori does not disclose a method so that audio elements may be edited before being uploaded. MS Recorder teaches that it is known to create and edit sounds on a local machine (figures 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to edit sounds locally, as taught by MS Recorder, with a method of producing and viewing a presentation, in order to allow users to more quickly edit the audio elements of presentations than if they were forced to only edit sounds on the client system.

Claim 25 is similar in scope to claim 9, and is therefore rejected under similar rationale.

As per dependant claim 10, which is dependent on claim 9, Shiimori teaches uploading (column 7, lines 46-48) but does not teach the uploading to be performed using an ActiveX control. However, Official Notice is taken that using ActiveX imbedded in a web page to control uploading is well known in the art. It would have been obvious to one of ordinary skill in the art

at the time the invention was made to implement ActiveX control as the method of uploading as this allows for an interactive way for users to more efficiently upload files to the client system.

As per claim 11, which is dependent on claim 10, Shiimori teaches that associating is performed by a client system (column 4, lines 34-36).

As per claim 12, which is dependent on claim 11, Shiimori teaches editing more than one audio visual element at one time (Column 2, lines 44-53).

Claims 27 and 28 are similar in scope to claims 11 and 12, respectively, and are therefore rejected under similar rationale.

13. Claims 13-15 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori (US # 6567983) in view of Microsoft Outlook 2000 ("MS Outlook", Microsoft Screen Dumps figures 3-6) and Lemelson et al. ("Lemelson", US # 6608972) and ("MS Recorder", Microsoft Screen Dumps figures 1-2) as applied to claim 12, and further in view of Ofoto.com's Press Materials ("Ofoto", http://www.ofoto.com, see attached article).

As per dependent claims 13 and 15, Shiimori teaches a method of producing and viewing an audio-visual presentation under the control of a client system for access by creator clients and guest clients. Shiimori does not disclose that the presentation materials may be edited only by the creator client or that guest clients may perform only steps (g) through (k) [*as noted earlier, claim 15 is rejected based on USC 112. Therefore, only sections g, i, and k will be addressed.*]

As per claim 13, Ofoto teaches that it was known to allow only creators editing privileges (page 1, ¶4, 3rd sentence).

As per claim 14, which is dependent on claim 13, Shiimori teaches rearranging the order of the audio visual elements in an audio visual presentation (column 2, lines 44-53).

As per claim 15, Ofoto also teaches that is was known to display presentations to guests and allow guests to purchase hard copies of presentation elements (page 1, ¶2, sentence 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability for creators only to edit presentations and guests only to view and order presentations, as taught by Ofoto, with a method of producing and viewing a presentation, in order allow people to share their experiences with friends, families, clients, or business associates without having their guests change any of the presentation's look or feel. Furthermore, it would be a beneficial business practice to sell elements of a presentation or the whole presentation as a profit making venture.

Claims 29, 30, and 31 are similar in scope to claims 13, 14, and 15, respectively, and are therefore rejected under similar rationale.

14. Claims 16-17 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori (US # 6567983) in view of Microsoft Outlook 2000 ("MS Outlook", Microsoft Screen Dumps figures 3-6) and Lemelson et al. ("Lemelson", US # 6608972) and Microsoft Sound Recorder ("MS Recorder", Microsoft Screen Dumps figures 1-2) and Ofoto.com's Press Materials ("Ofoto", http://www.ofoto.com, see attached article) as applied to claim 15, and further in view of Catona (US #6288319).

As per dependent claims 16 and 17, Shiimori teaches a method of producing and viewing an audio-visual presentation under the control of a client system for access by creator clients and guest clients. Shiimori does not disclose generating a unique URL by the client system for each guest client and, sending an e-mail to the guest client notifying the guest client that the audio visual presentation may be viewed, the e-mail containing an unique URL in the form of a link

from the guest client to the audio visual presentation. He also does not disclose linking the guest client to the audio visual presentation when the guest client clicks on the URL link contained in the e-mail from the client system. Catona teaches that it is known to generate a unique URL, send this URL in an email to a guest, and allow the guest immediate access to the presentation by clicking on the URL (column 3, lines 46-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a method to allow guests to access the presentation using a URL link sent to them via e-mail, as taught by Catona, with a method of producing and viewing a presentation, in order to allow easier and faster access to the presentation materials.

Claims 32 and 33 are similar in scope to claims 16 and 17, respectively, and are therefore rejected under similar rationale.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nelson et al. (US # 6195093), Mayle et al. (US # 6018774), Gorbet et al. (US # 6072480), Barraclough et al. (US # 6301607), and Manolis et al. (US # 6583799) all teach methods of producing and displaying a presentation both locally and over a wide area network.

Flynn et al. (US # 6618747) teach a method of notifying the creator of a document when the document is viewed.

Linden et al. (US # 6360254) teach using a specific URL with unique tokens that allows only users with that URL to link to the matching presentation on the internet.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan S Golinkoff whose telephone number is 703-305-8771. The examiner can normally be reached on 5 - 4/9 Compressed Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Jordan Golinkoff
Patent Examiner
October 7, 2003

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